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JUN -2 2003

Paper No. 33

In re Application of :
Luis J. Rodriguez : DECISION ON PETITION
Application No. 09/978,215 :
Filed: October 15, 2001 :
For: Self Sealing Letter Sheets :

This is a decision on the petition filed by facsimile transmission on May 26, 2003. The petition is being treated as a request to correct the record.

The petition is granted-in-part to the extent indicated below.

First, with respect to paper No. 29 dismissing the petition of May 12, 2003 for being untimely, petitioner is advised that the last paragraph of paper No. 25 (a decision on petition) establishes a two month period for filing a request for reconsideration. This is normal procedure with respect to a petition that has been dismissed; petitioner is accorded a period in which to bring to the deciding official's attention any facts bearing on the requested relief not previously brought forth in the petition, or to request clarification, correction, etc. The last paragraph of paper No. 25 does not establish that the petition filed on January 9, 2003 (paper No. 18) that was dismissed because it was not timely filed would somehow be rendered timely if petitioner requested reconsideration. The record clearly shows that the requested relief on January 9, 2003 was not requested in a timely manner, and that petitioner himself recognized this fact and petitioned under 37 CFR 1.183 to waive 37 CFR 1.181(f) so as to have the petition considered timely.

As to the matter of paper No. 13, filed on October 17, 2002, and endorsed as "Amendment C", the amendments therein were refused entry by the Primary Examiner. See paper No. 13, an advisory action dated October 25, 2002. This refusal extends not only to the amendments (that is, to changes in the specification and changes to the claims), but to such any and all exhibits and attachments that were not previously submitted in the record prior to the filing of paper No. 13. See paper No. 15, paragraph 6. Notwithstanding petitioner's attempt to distinguish between amendments (that is, "changes") and "arguments and supportive attachments", there is no basis for entering "attachments" into the record after final action because "attachments" are not "amendments." Amendments are not entered in part, see MPEP §§ 714.19 and 714.20. Moreover, amendments after final action are not entered as a matter of right, and applicant no longer has any right to unrestricted prosecution. See MPEP § 714.12 and 714.13. There is no greater right to enter new exhibits into the record than there is to enter new claims.

On the other hand, arguments discussing why the final rejection dated September 11, 2002 was in error with respect to the application of prior art that apply to claims and to exhibits and attachments of record in the application prior to the final rejection will be considered to be of record, and available for consideration on appeal. Arguments discussing why the amendments to the claims proposed in Paper No. 13 make those claims allowable are not relevant, whether applicant wishes to consider them as entered in the record or not, since those amended claims filed in paper No. 13 are not of record.

As to the reference to the non-entry of amendment B, that reference was meant to be limited to


non-entry of the substitute specification that was filed on August 23, 20002, concurrently with Amendment B. Amendment B was apparently entered by the examiner, but remains objected to for the introduction of new matter. See paper No. 12. Thus petitioner is correct; amendment B is entered of record. Again, the substitute specification filed concurrently therewith is not entered.

With respect to entry of the substitute specification, the refusal to enter the substitute specification occurred on September 11, 2002, in paper No. 12. Even taking the refusal dates as October 25, 2002 and October 29, 2002, the first request for relief therefrom was not earlier than by petition filed on January 9, 2003 (paper No. 14, filed on October 17, 2002, is confined to the issue of admission of a model and was "granted" by the examiner and ratified by the undersigned in paper No. 31; it is noted that, per paper No. 15, paragraph 6, "affidavit 4" was not entered by the examiner). January 9, 2003 is more than two months subsequent to October 29, 2002, and as noted, *supra*, petitioner himself recognized this and petitioned unsuccessfully to have 37 CFR 1.181(f) waived. See paper Nos. 18 and 23. No original petition to enter the substitute specification was timely filed, and the subsequent filing of a "renewed" petition does not cure that deficiency.

In summary, the record is clarified to indicate that amendment B (but not the concurrently filed substitute specification) is entered. The record is further clarified to indicate that arguments filed on October 17, 2002 that relate to **claims and to exhibits and attachments of record in the application prior to the final rejection** are certainly in the record. However, arguments that apply to the claims and specification as proposed to be amendment in amendment C are **not** entered in the record. The record is further clarified by noting that when a petition is dismissed, an invitation to file a renewed petition within two months of the decision dismissing the petition is not a license that subsequently converts the renewed petition into a timely original petition. The petition under 37 CFR 1.181 filed on January 9, 2003 was not timely filed, and a waiver of 37 CFR 1.181(f) has been refused by the Office of Petitions. No subsequently filed renewed petition can make an originally filed petition timely. No renewed petition presented any basis for excusing the untimely filing of an original petition.

The application is being forwarded to the examiner for action on the appeal brief. The examiner is required to make sure that all of the amendments set forth in amendments A and B have been properly physically entered into the application. The examiner is further required to review amendment C and to consider all arguments therein that relate to the claims and specification as amended prior to the final rejection.

PETITION GRANTED-IN-PART.


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Examining Groups 3710 and 3720

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